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Patent

Attorney Docket No: ART-00102.P.1

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)

Xu et al.)

Examiner: Do, Pensee T.

Application Number: 09/668,737)

Group Art Unit: 1641

Filed: October 10, 2000)

For: COMPOSITIONS AND)
METHODS FOR SEPARATION OF)
MOIETIES ON CHIPS)

Assistant Commissioner for Patents
Washington D.C., 20231

Sir,

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Office Action mailed November 18, 2001, Applicants submit the following election and traverse. Applicants submit this response within one month of that mailing date. Accordingly, this Response is timely filed.

I. ELECTION

Applicants elect the invention of Group II. This election is made with traverse.

The above-identified patent application has been examined for restriction purposes only.

The Examiner has set forth the following groups:

| Group Number | Claims | Subject Matter |
|--------------|--|---|
| I | 1-3 and 7-14 | A solution that modifies a dielectric property of a sample component and has a conductivity such that sample components can be dielectrophoretically separated. |
| II | 15 - 19, 21, 26-32, 34, 41-47, 51, 52, 54, and 57-60 | A method of using the solution of claim 1 or a method of using the solution of claim 7 to separate sample moieties. |

In the Office Action, the Examiner restricts the claims to two distinct and independent inventions. For the following reasons, Applicants traverse this restriction requirement.

B. Standard for Restriction

The M.P.E.P. (Aug. 2001) sets forth the standard for restriction requirements.

There are two criteria for a proper requirement for restriction between patentably distinct intentions:

- A. The inventions must be independent (see M.P.E.P. §802.01, §806.04, §808.01) or distinct as claimed (see M.P.E.P. §806.05 - §806.05(i); and
- B. There must be a serious burden to the examiner if restriction is not required (see M.P.E.P. §803.02, §806.04(a) -(i), §808.01(a) and §808.02) M.P.E.P. § 803 (Aug. 2001).

The term “independent” (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not useable together as disclosed or (2) process and apparatus incapable of being used in practicing the process.
M.P.E.P. § 802.01 (Aug. 2001).

B. The Claims

The claims of Groups I and II, while being patentably distinct, do not require restriction as they are connected by a single, searchable unifying relationship that connects the claims in design. M.P.E.P. § 802.01 (Aug. 2001). Because of the single, searchable unifying relationship, the Examiner would not be seriously burdened by searching and examining the claims together in a single application.

The claims are connected by a single searchable unifying relationship, namely a solution that modifies a dielectric property of a sample component and can be used to dielectrophoretically separate a sample component, and methods that use such a solution to separate sample components. This unifying relationship connects the claims of the groups in design. The single searchable unifying element can be primarily searched by electronically searching key words.

Because the claims of Groups I and II are patentably distinct, are not independent and are connected by a single searchable unifying element, the Examiner would not be seriously burdened by examining these claims together. Accordingly, Applicants request that the Examiner join the claims of Groups I and II.

III. CONCLUSION

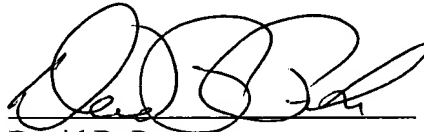
Based on the commonality of the subject matter of the amended claims, Applicants request that the Examiner join the claims of Groups I and II. For completeness, Applicants have elected the claims of Group II for examination. Applicants respectfully submit that the claims are ready for examination and in condition for allowance.

Please apply any charges not covered, or any credits, to Deposit Account Number 501321 in the name of David R. Preston & Associates, having Customer Number 24232.

Respectfully submitted,

Date:

Dec 12, 2002



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